

REMARKS

By the above amendments, claim 1 is revised and claims 2 and 3 are canceled. Claims 8-24 stand withdrawn from consideration such that only claims 1 and 4-7 are before the Examiner for consideration on their merits.

First, Applicant confirms the election of the Group I invention.

However, Applicant wishes to traverse the restriction requirement and believe that it is improper and that the remaining claims must be considered under the PCT unity of invention rules. As a basis for contending that the claims can be subject to restriction requirement, the Examiner alleges that the single general inventive concept is the magnesium composite powder. Then, the Examiner cites United States Patent No. 3,957,483 to Suzuki as grounds that the magnesium composite powder is not novel, and therefore, this concept cannot be considered a single general inventive concept running through the claims.

The problem with the restriction requirement is the allegation that Suzuki teaches the magnesium composite powder as claimed is incorrect. In fact, Suzuki does not teach the inventive composite powder. Therefore, the composite material made from the composite powder, (claims 8-11), the method of making the composite powder (claim 12), and the method of making the composite material using the composite powder (claims 13-24) should all be examined together.

A key feature of the claims that the Examiner has overlooked is that the coarse particle is a magnesium alloy, not magnesium. In Suzuki, the composite particle is made up of a magnesium article having attached in finely divided form iron, zinc, chromium, aluminum and manganese to the surface thereof. As is clear from the

Examples, the coarse particles of Suzuki are magnesium, not a magnesium alloy.

Therefore, Suzuki cannot be said to teach the single general inventive concept involving a composite powder that has magnesium alloy coarse particles and there is no basis upon which a restriction requirement can be made. In light of this, the restriction requirement is improper and must be withdrawn.

Turning now to the prior art rejection, claims 1-4 and 7 stand rejected under 35 U.S.C. § 102(b) based on the Suzuki patent. Claims 5 and 6 are considered obvious under 35 U.S.C. § 103(a) when Suzuki is combined with JP 62 278201 (JP '201).

It is respectfully submitted that Suzuki neither anticipates nor renders obvious claim 1. In review, claim 1 defines, among other things, a fine-grained powder comprising a Si component. Moreover, claim 1 recites that the composite powder produces Mg_2Si particles dispersed in the matrix as a result of the presence of the Mg in the coarse particles and Si in the fine-grained powder.

Suzuki does not teach the composite powder of claim 1 for the simple reason that there is no disclosure relating to a fine-grained powder having a Si component. In Suzuki, metals or their oxides associated with the magnesium preparations include iron, zinc, chromium, aluminum, and manganese, see col. 2, lines 16-19. There is no mention of Si in this group so a rejection based on 35 U.S.C. § 102(b) cannot be made against claim 1 in its amended form.

Since anticipation of a claim requires the presence of each and every element in the prior art and Suzuki fails to teach a fine-grained powder comprising a Si component, the rejection of claim 1 based on solely on Suzuki must be withdrawn.

Lacking a basis to allege anticipation, the Examiner can only rely on 35 U.S.C. § 103(a) to further reject claim 1. First, JP '201 cannot make up for the failing in Suzuki. JP '201 discloses to stick fine particles to a surface of coarse particles to form aggregates of particles. The coarse particles of JP '201 are iron particles with a maximum size of 250 μ m. The fine particles are Ni, Cu, Mo, or the like. This reference does not teach magnesium alloy coarse particles or fine-grained powders comprising a Si component. Therefore, even if JP '201 were combined with Suzuki, the invention of claim 1 would still not be present.

Since JP '201 does not teach the feature of claim 1 missing in Suzuki, the Examiner must either find some other reason to modify Suzuki such that it could be alleged to include Si as one of the metals along with already disclosed metals of iron, zinc, chromium, aluminum, and manganese. However, there is not even a hint in Suzuki that Si could be one of the components made part of the magnesium preparation. Any allegation that one of skill in the art could be led to use Si in place of the disclosed metals is the blatant reliance on hindsight. Any subsequent rejection of this nature would be totally improper and could not be sustained on appeal.

In light of the above, claim 1 cannot be anticipated by Suzuki since this reference does not include the features presently claimed. Further, there is no legitimate basis to conclude the Suzuki, alone, or with JP '201, can somehow be modified to support a rejection based on obviousness. Therefore, it submitted that the rejection of claim 1 must be withdrawn.

Claims 4-7 are also in condition for allowance by reason of their dependency on claim 1.

Since the claim 8 composite material is derived from the patentable composite powder of claim 1, claims 8-11 are also patentably distinguishable over Suzuki. Moreover, the method of making the patentable composite powder and its use in making the composite material are also believed to be distinguishable over the prior art.

Accordingly, the Examiner is respectfully requested to examine this application in light of this response and pass all pending claims onto issuance.

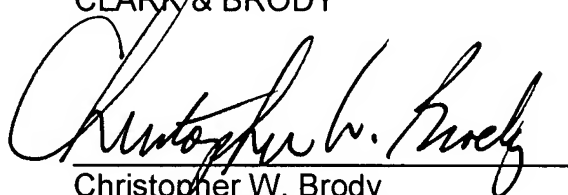
If the Examiner believes that an interview would be helpful in expediting the allowance of this application, the Examiner is requested to telephone the undersigned at 202-835-1753.

The above constitutes a complete response to all issues raised in the Office Action dated April 27, 2007.

Again, reconsideration and allowance of this application is respectfully requested.

Applicant petitions for a one month extension of time and a check in the amount of \$120.00 is attached herewith. Please charge any fee deficiency or credit any overpayment to Deposit Account No. 50-1088.

Respectfully submitted,
CLARK & BRODY

A handwritten signature in black ink, appearing to read "Christopher W. Brody", written over a horizontal line.

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